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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/527,453	03/17/2000	MASAAKI HORI	105637	3066

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EXAMINER

BURLESON, MICHAEL L

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/527,453

Applicant(s)

HORI, MASAOKI

Examiner

Michael Burleson

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Information Disclosure Statement

2. The information disclosure statement (IDS) was submitted on March 17, 2000. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Ishibashi et al. US 6374291.

Regarding claim 1, Ishibashi et al. teaches of a communication terminal device that has the functions of communicating with the internet and facsimile functions (column 3, lines 21-27), which reads on a facsimile apparatus that transmits facsimile data by attaching facsimile data to electronic mail (e-mail) for use with an information network. Ishibashi et al. teaches of an operating part (5) that is used as a key pad (column 3, lines 42-46) and he teaches of inputting header information of To: (recipient) (column 5, lines 1-4). This reads on a recipient's information inputting device that inputs information of a recipient to whom the e-mail is transmitted. Ishibashi et al. teaches of an operating part (5) that is used as a key pad (column 3, lines 42-46 and figure 10) and he teaches of inputting header information of Cc: (multiple addresses) (column 5, lines 1-6 and figure 10). This reads on a notation inputting device that inputs notation that informs whether the e-mail is addressed to the recipient or the e-mail is transmitted as a courtesy copy, and that correlates the notation to the recipient's information. Ishibashi et al. teaches of a TA/DSU (9) that receives an e-mail with facsimile data attached to it by a mail editor (24) and transmits the e-mail (column 4, lines 63-65 and figures 2 and 6), which reads on a transmission device that transmits facsimile data by attaching the facsimile data to the e-mail, based on recipient's information input by the recipient's information inputting device and the notation input by the notation inputting device.

3. Regarding claim 2, Ishibashi et al. teaches of an operating part (5) that is used as a key pad (column 3, lines 42-46) and he teaches of inputting header information of To: (recipient) (column 5, lines 1-4). This reads on the recipient's information inputting device inputs a piece of a recipient's information for one piece of the e-mail.

3. Regarding claim 3, Ishibashi et al. teaches of an operating part (5) that is used as a key pad (column 3,lines 42-46) and inputting header information of Cc: (multiple addresses) (column 5,lines 1-6 and figure 10), which reads on a notation inputting device inputs a plurality of notations and correlates each of the plurality of notations to each of the pieces of the recipients information input by the recipient's information inputting device.

4. Regarding claim 4, Ishibashi et al. teaches of an operating part (5) that is used as a key pad (column 3,lines 42-46) and he teaches that a message can be written in the body of the attachment (figure 10). This reads a writing device that writes information into a body of the e-mail before transmitting the e-mail by the transmission device.

5. Regarding claim 5, Ishibashi et al. teaches of a scanner (2) (column 3,lines 34-39), which reads on a reading device that reads from an original document, the facsimile data to be attached to e-mail and then transmitted.

6. Regarding claim 6, Ishibashi et al. teaches of a modem (10) (column 3,lines 66-67 and column 4,lines 1-5), which reads on a facsimile data transmission/reception device that only transmits/receives the facsimile data by a public line.

Regarding claim 17, Ishibashi et al. teaches of ROM (6) (column 3,lines 45-54), which reads on a storage medium for storing a program for controlling a facsimile apparatus that transmits facsimile data by attaching the facsimile data to electronic mail for use in an information network and a recipient's information inputting program for inputting information of a recipient to whom the e-mail is transmitted, a notation inputting

program for inputting notation that informs whether the e-mail is addressed to the recipient or the e-mail is transmitted as a courtesy copy and for correlating the notation to the recipient's information and a transmission program for transmitting the facsimile data by attaching the facsimile data to the e-mail, based on the recipient's information input by the recipient's information inputting program and the notation input by notation inputting program.

Claim Rejections - 35 USC § 103

7. Claims 7-16 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishibashi et al. US 6374291 in view of Sidhu et al. US 5734901.
8. Regarding claim 7, Ishibashi et al. teaches of a communication terminal device that has the functions of communicating with the internet and facsimile functions (column 3, lines 21-27), The communication terminal device contains a operating part (5) that is used as a key pad (column 3, lines 42-46) and inputs header information of To: (recipient) (column 5, lines 1-4) and Cc: (multiple addresses) (column 5, lines 1-6 and figure 10). He also teaches that of TA/DSU (9) that receives an e-mail with facsimile data attached to it by a mail editor (24) and transmits the e-mail (column 4, lines 63-65 and figures 2 and 6). This reads on a facsimile apparatus that broadcasts to a plurality of recipients, facsimile data by attaching the facsimile data to electronic mail (e-mail) for

use with an information network comprising of a recipient's information inputting device that inputs pieces of recipient's information for one piece of the e-mail to be transmitted.

9. Ishibashi et al. fails to teach of a disclosure information inputting device that inputs disclosure information as to whether or not disclosure of other broadcast recipients is required, according to the pieces of the recipient's information input by the recipient's information inputting device, and that correlates the disclosure information to the recipient's information and a transmission device that transmits facsimile data by attaching the facsimile data to the e-mail, based on pieces of recipient's information input by the recipient's information inputting device and the disclosure information input by the disclosure information inputting device.

10. Sidhu et al. teaches of an addressing panel (800) (column 12, lines 11-15 and figure 8), which reads on a disclosure information inputting device that inputs disclosure information as to whether or not disclosure of other broadcast recipients is required, according to the pieces of the recipient's information input by the recipient's information inputting device, and that correlates the disclosure information to the recipient's information. He teaches that facsimile addresses can be used to transmit data via e-mail (column 12, lines 17-20). The computer system (100) transmits electronic messages between systems (column 5, lines 36-38), which reads on a transmission device that transmits facsimile data by attaching the facsimile data to the e-mail, based on pieces of recipient's information input by the recipient's information inputting device and the disclosure information input by the disclosure information inputting device.

The communication terminal device of Ishibashi et al. could have easily been modified with the addressing panel and computer system of Sidhu et al. This modification would have been obvious to one skilled in the art at the time of the invention to transmit facsimiles via e-mail to other recipients and to send blind copies of e-mails to other recipients.

11. Regarding claim 8, claim 8 is rejected for the same reasons as claim 4.
12. Regarding claim 9, claim 9 is rejected for the same reasons as claim 5.
13. Regarding claim 10, claim 10 is rejected for the same reasons as claim 6.
14. Regarding claim 11, Ishibashi et al. teaches all of the limitations of claim 11, but fails to teach of a disclosure information inputting device and a transmission device.

Sidhu et al. teaches of an addressing panel (800) that has a Cc: icon (621) which can be selected by the user (column 10, lines 60-67, column 12, lines 11-21 and figure 8), which reads on a notation inputting device that inputs notation that informs whether the e-mail is addressed to the recipient or the e-mail is transmitted as a courtesy copy, and that correlates the notation to the recipient's information. He teaches of an addressing panel (800) (column 12, lines 11-15 and figure 8), which reads on a disclosure information inputting device that inputs disclosure information as to whether or not disclosure of other broadcast recipients is required, according to the pieces of the recipient's information input by the recipient's information inputting device, and that correlates the disclosure information to the recipient's information. He also teaches that facsimile addresses can be used to transmit data via e-mail (column 12, lines 17-20). The computer system (100) transmits electronic messages between systems (column 5,

lines 36-38), which reads on a transmission device that transmits facsimile data by attaching the facsimile data to the e-mail, based on recipient's information input by the recipient's information inputting device, the notation input by the notation inputting device and the disclosure information input by the disclosure information inputting device.

The communication terminal device of Ishibashi et al. could have easily been modified with the addressing panel and computer system of Sidhu et al. This modification would have been obvious to one skilled in the art at the time of the invention to transmit facsimiles via e-mail to other recipients and to send courtesy copies and blind copies of e-mails to other recipients.

15. Regarding claim 12, claim 12 is rejected for the same reasons as claims 4 and 8.

16. Regarding claim 13, claim 13 is rejected for the same reasons as claims 6 and 10.

17. Regarding claim 14, Sidhu et al. teaches of an addressing panel (800) (column 10, lines 60-67, column 12, lines 12-15 and figure 8), which reads on notation inputting device and the disclosure information inputting device are a common device and the notation and the disclosure information are common information.

18. Regarding claim 15, Ishibashi et al. teaches of ROM (6) (column 3, lines 45-54), which reads on a storage medium for storing a program for controlling a facsimile apparatus that transmits facsimile data by attaching the facsimile data to electronic mail for use in an information network, a recipient's information inputting program for inputting information of a recipient to whom the e-mail is transmitted and notation

inputting program for inputting notation that informs whether the e-mail is addressed to the recipient or the e-mail is transmitted as a courtesy copy and for correlating the notation to the recipient's information.

Ishibashi et al. fails to teach of a storage medium that stores a disclosure information inputting program and a transmission program.

Sidhu et al. teaches of a static memory (106) (figure 1), which reads on a storage medium for storing a disclosure information inputting program for inputting disclosure information as to whether or not disclosure of other recipients is required, according to the recipient's information input by the recipient's information inputting program and for correlating the disclosure information to the recipient's information and a transmission program for transmitting the facsimile data by attaching the facsimile data to the e-mail, based on the recipient's information input by the recipient's information inputting program, the notation input by notation inputting program and the disclosure information input by the disclosure information input program.

The ROM of Ishibashi et al could have easily been modified the static memory of Sidhu et al. This modification would have been obvious to one skilled in the art at the time of the invention in order to store the disclosure and transmission programs.

19. Regarding claim 16, Ishibashi et al. teaches of ROM (6) (column 3, lines 45-54), which reads on a storage medium for storing a program for controlling a facsimile apparatus that transmits facsimile data by attaching the facsimile data to electronic mail for use in an information network and a recipient's information inputting program for inputting information of a recipient to whom the e-mail is transmitted.

Ishibashi et al. fails to teach of a storage medium that stores a disclosure information inputting program and a transmission program.

Sidhu et al. teaches of a static memory (106) (figure 1), which reads on a storage medium for storing a disclosure information inputting program for inputting disclosure information as to whether or not disclosure of other broadcast recipients is required, according to the pieces of the recipient's information input by the recipient's information inputting program and for correlating the disclosure information to the recipient's information and a transmission program for transmitting the facsimile data by attaching the facsimile data to the e-mail, based on the recipient's information input by the recipient's information inputting program and the disclosure information input by the disclosure information inputting program.

The ROM of Ishibashi et al. could have easily been modified the static memory of Sidhu et al. This modification would have been obvious to one skilled in the art at the time of the invention in order to store the disclosure and transmission programs.

20. Regarding claim 18, Sidhu teaches that addressing panel (800) BCC is available at the position of CC icon (621) (column 10, lines 63-67), which reads on the disclosure information is a notation of a blind courtesy copy.

21. Regarding claim 19, claim 19 is rejected for the same reasons as claim 18.

22. Regarding claim 20, claim 20 is rejected for the same reason as claim 18.

23. Regarding claim 21, claim 21 is rejected for the same reason as claim 18.

Conclusion

1. Any inquiry concerning this communication should be directed to Michael Burleson whose telephone number is (703) 305-8683 and fax number is (703) 746-3006. The examiner can normally be reached Monday thru Friday from 8:00 a.m. – 4:30p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached at (703) 305-4863

Michael Burleson
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Art Unit 2626

MB

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March 18, 2005

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SUPERVISORY PATENT EXAMINER